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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,297	01/04/2000	JAMES R. TIGHE	062891.0381	9048

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BAKER & BOTTS LLP
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EXAMINER

BLOUNT, STEVEN

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 06/04/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/477,297

Applicant(s)

TIGHE ET AL.

Examiner

Steven Blount

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9-11,13-18,20,21 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9-11,13-18,20,21 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how much of the claim is being "Or'd" in view of the location of the word "or" in line 16. If applicant means to say that you either convert the data from a first compression format or you convert from a first signaling format to a second signaling format, then a comma should probably precede the word "or" instead of a semicolon (It is possible that this is a minor typographical error in which the word "and" was intended; but as it stands, everything above the word "or" could be considered an alternate to what comes after it, though this is unclear).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4 - 5, 9, 10-11, 13, 16 - 18, 20 - 21, 24 - 25, and 28 - 29 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. patent 6,449,269 to Edholm in view of U.S. patent 6,321,336 to Applegate et al.

Applicant is requested to refer to the rejection made in paper number 15 for a discussion of this rejection, as here it is being simply repeated.

5. Claims 6, 14, and 26 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. patent 6,449,269 to Edholm and U.S. patent 6,321,336 to Applegate et al as applied above, and further in view of U.S. patent 5,896,379 to Haber.

Applicant is requested to refer to the rejection made in paper number 15 for a discussion of this rejection, as again it is here being simply repeated.

6. Claims 1, 4 – 5, 9 – 10, 11, 13, 16 - 18, 20 – 21, 24 – 25, and 28 - 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,272,633 to Duke et al in view of U.S. patent 6,321,336 to Applegate et al.

With regard to claim 1, Duke et al teaches telephony intermediary 210, wherein 210 is an encoder (col 4 lines 2+) that has first and second ports (see the arrows entering and leaving the "box" 210) associated with the first and second telephony devices 110 and 150 (fig 1) wherein the payload is received by the intermediary and is encrypted (ie, it is manipulated - see box 230) and communicated to the second telephony device. Duke et al also mentions the fact that there are a limited number of types of secure telephone equipment in col 1, lines 40+. Duke et al does not however teach modifying the source address information associated with telecommunication data to specify the port of the virtual intermediary. This is taught in Applegate et al. See col 5, lines 55 to 60.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided an additional form of secure communication to Duke et al by

hiding the source address, in light of the teachings of Applegate et al, in order to further secure the communication and prevent unauthorized reception of the conversation.

With regard to claim 4, see how IP is taught in both Applegate and Duke.

With regard to claim 5, see how UDP is taught in Duke in col 5.

With regard to claim 9, see col 7, lines 30+ of Applegate.

With regard to claim 10, see figure 5 of Applegate.

With regard to claims 11, 13, and 16 – 18, see the rejections above.

With regard to claim 20, see the session control block 364 in Applegate (fig 5).

With regard to claims 21, 24 – 25, and 28 – 29, each of these process steps are discussed in the rejection of the apparatus claims above.

7. Claims 6, 14, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,272,633 to Duke et al in view of U.S. patent 6,321,336 to Applegate et al as applied above, and further in view of U.S. patent 5,896,379 to Haber.

Duke/Applegate et al teach the invention as described above, but do not teach duplicating the data. This is taught in Haber. See col 1 lines 48+ and also col 7 lines 25+.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have duplicated the data of Duke/Applegate, in light of the teachings of Haber, in order to provide for the ability to broadcast a conversation to many end users.

8. Claims 7, 15, 27 and 30 are rejected under 35 U.S.C. 103(a) as being obvious over either one of U.S. patent 6,272,633 to Duke et al, or U.S. patent 6,449,269 to

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Edholm in view of U.S. patent 6,321,336 to Applegate et al, and further in view of U.S. patent 6,002,689 to Christie et al.

(Duke et al or Edholm)/Applegate et al teach the invention as described above, but do not teach converting the data format so that it is compatible with a second telephony device.

Christie teaches a device that converts user communications from one format to another. See the abstract, lines 14+, and also col 20, lines 50+.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the intermediary of (Duke et al or Edholm)/Applegate et al with a protocol converter, in light of the teachings of Christie et al, in order to allow the participants in the conversation to converse over networks of different types.

With regard to claim 30, see the above rejections, in addition to the fact that compression is taught in Duke and Edholm.

Response to Arguments

9. Applicant's arguments filed 3/19/04 have been fully considered but they are not persuasive.

The applicant has argued that there is no motivation to combine the Edholm and Applegate (and Haber) references. The examiner disagrees.


Applicant states that Edholm "does not disclose the use of its invention for security purposes" (page 11 lines 11+. Note that applicants statement following the quoted portion that "nor does the reference disclose the need to perform address

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translations" is really a restatement that Edholm does not disclose the use of the invention for security purposes).

Applegate et al is used to provide "Secure Communication" (title of the invention). The invention taught in Applegate is generic to many forms of packet communications, and the invention has not been limited to the idea of protecting IP data to any one application. Edholm teaches communicating over an IP network wherein an intermediary controller manipulates the data. While Applegate et al does not explicitly mention the need or desire for applying a secure connection between the end members, the examiner believes that it is self evident that people (including one skilled in this art, since nearly everyone communicates using a phone) communicating on opposite ends of a phone conversation almost always desire that their conversation be kept in confidence, such that it would be desirable and perfectly obvious to one of ordinary skill in this art, aware of these two references, to find it obvious to combine them to form a device that is capable of allowing for such a secure conversation.

10. Examiner Steven Blount may be reached at 703-305-0319 between the hours of 9:00 and 5:30 Monday through Friday.


Ajit Patel
Primary Examiner

SB


5/24/04